

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY S. BACHAND, SOUMYA ROY,
JEFFREY A. TAYLOR and CRAIG E. ZIMMERMAN



Appeal No. 2003-0255
Application 09/150,692

ON BRIEF

Before OWENS, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, and 14 through 20.

As preliminary background, we note that appellants filed a first Brief on June 18, 2001 (Paper No. 17). Subsequently, in the Office Action of Paper No. 18, the examiner responded to the Brief filed on June 18, 2001, by reopening prosecution and setting forth a new ground of rejection. In response, on March 4, 2002 (Paper No. 20), appellants filed a Supplemental Appeal Brief. In response to this Supplemental Appeal Brief, the examiner, in Paper No. 21, sent a Notification of Non-Compliance. In response to the Notification of Non-Compliance, appellants filed an amended Appeal Brief on June 25, 2002 (Paper No. 23). In response to the amended Appeal Brief filed on June 25, 2002, the

Appeal No. 2003-0255
Application No. 09/150,692

examiner provided the examiner's Answer of Paper No. 24. The examiner's Answer replicates the rejections of the Office Action of Paper No. 18.

In this decision, we refer to the amended Appeal Brief filed on June 25, 2002.

Claim 14 stands rejected under 35 U.S.C. § 102(a), as being anticipated by Laschkewitsch.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch.

Claim 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Pulici.

Claims 16 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Zoss.

Claims 5 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Pulici and further in view of Zoss.

The references relied upon by the examiner as evidence of unpatentability are:

Pulici	3,669,007	Jun. 13, 1972
Zoss	5,853,836	Dec. 29, 1998
Laschkewitsch et al. (Laschkewitsch)	WO 97/33822	Sep. 18, 1997

On page 3 of the brief, appellants group the claims as follows:

- I. claim 14
- II. claim 15
- III. claim 16
- IV. claims 17 and 20
- V. claim 18
- VI. claim 19
- VII. claims 1 and 3
- VIII. claims 3 and 5

- IX. claim 4
- X. claims 6 and 7
- XI. claim 8
- XII. claim 9
- XIII. claim 10

We note that a claim must be separately argued regarding patentability; otherwise, the claims stand or fall together. In re Dance, 160 F.3d 1339, 1340, 48 USPQ2d 1635, 1636 (Fed. Cir. 1998). See also, In re Nielson, 816 F.2d 1567, 1571, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

We observe that appellants provide arguments for the grouping of claims 17 and 20, so we consider claim 17 from this grouping. On pages 12-13 of the Brief, appellants argue claims 18 and 19 in the context of claim 4 (use of water as the adhesive). Hence, claims 18 and 19 stand or fall with claim 4, and we consider claim 4. On page 13 of the brief, appellants argue claims 1 and 2 together, for similar reasons with respect to claim 14. Because claim 1 is rejected separately from claim 14 by the examiner, we consider claim 1 separately from claim 14. On page 16 of the Brief, appellants argue claims 3 and 5 for similar reasons with respect to claims 15 and 16. We therefore consider claims 15 and 16. We note, however, that the examiner has separately rejected claims 5-10, and we therefore also consider claim 5. On page 17 of the Brief, appellants argue claims 6 and 7 together for the same reason provided with respect to claim 16. Our consideration of claim 16 therefore addresses these claims. On page 17 of the Brief, appellants argue claim 8 for the same reasons with respect to claims 17 and 20; hence, as discussed above, our consideration of claim 4 addresses these claims. On page 17 of the Brief, appellants argue claims 9 and 10

in the context of the use of water recited in claim 4. Hence our consideration of claim 4 also addresses these claims.

In view of the above, we therefore consider claims 1, 4, 5, 14, 15, 16, and 17. 37 CFR § 1.192(c)(7)(8)(2001). A copy of each of these claims is set forth in the attached appendix.

OPINION

I. The rejection of claim 14 under 35 U.S.C. § 102 as being anticipated by Laschkewitsch

As discussed by the examiner on page 7 of the answer, claim 14 does not recite "water"; only a food item having an area of greater moisture content than another area of the food item. We also agree with the examiner that Laschkewitsch's use of an edible adhesive, for example, corn syrup, provides for a portion of the food item having a moisture content greater than the moisture content of a second portion of the food item. We therefore are unconvinced by appellants' arguments regarding claim 14 set forth on pages 5 through 11 of the brief.¹

We note that a claim is anticipated when each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Because appellants have not shown that the drop of adhesive described, for example, on page 17 at lines 4 through 6 of Laschkewitsch, does not provide for a portion of the food item to have a moisture content greater than a portion that does not have

¹ We also agree with the examiner's comments made on page 7 regarding the Cherukuri reference. Throughout the brief, the appellants discuss the Cherukuri reference, but this reference is not used in any of the rejections.

the drop of adhesive, we affirm the rejection.

II. The Rejection of claim 15 under 35 U.S.C. § 103 over
Laschkewitsch

On page 4 of the answer, the examiner asserts that it would have been obvious to provide for a length, for the first portion, of approximately 10%, as claimed in appellants' claim 15, in view of Laschkewitsch, because Laschkewitsch does not recite the amount of edible adhesive used, but Laschkewitsch teaches applying adhesive to the trailing end only, and the coverage area would have been varied depending upon such factors as the type food and the type of adhesive used.

On page 11 of the brief, appellants argue that the source of moisture being approximately 10% of the elongated length of the strip of food and support material as recited in claim 15 insures sufficient adhesion strength while minimizing the possibility of a degradation of food in their rolled food item.

We note that it is impermissible to conclude that an invention is obvious based solely on what the examiner considers to be basic knowledge or common sense. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus, the burden is on the examiner to identify teachings in Laschkewitsch to support the conclusion that it would have been obvious to modify the teachings of Laschkewitsch to achieve the claimed invention set forth in appellants' claim 15. In the present case, the examiner has failed to meet this burden for the following reasons.

On page 8 of the answer, the examiner states that it would have been obvious to select the coverage area set forth in claim 15 depending on such factors as the type of food and the type of adhesive used. Yet, the examiner has not explained why one of

ordinary skill in the art would have been motivated to modify the drop of adhesive 125, described on page 17 of Laschkewitsch, such that it would cover a portion having a length approximately 10% of the length of the strip of support material and food between the trailing and leading edges. That is, the examiner does not explain that such a modification, in the context of Laschkewitsch (i.e., the particular rolled food product), would be desirable. Hence, we determine that the examiner's rejection can only be based on improper hindsight reasoning. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

We therefore reverse the rejection of claim 15.

III. The rejection of claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Pulici

We consider claims 1 and 4 in this rejection.

Beginning on page 13 of the Brief, appellants argue that claim 1 recites "spraying a deposit of a source of moisture." Appellants argue that Laschkewitsch discloses dispensing, placing or depositing a drop of corn syrup.

Beginning on page 4 of the Answer, the examiner's position is that Pulici teaches spraying water upon the food item in order to keep it in a rolled state and that it would have been obvious to have utilized water as the adhesive in Laschkewitsch and to have used spraying as a means for depositing the adhesive, as taught by Pulici.

On pages 13 through 15 of the Brief, the appellants argue that Pulici teaches use of water as a binder for flour based doughs, and does not teach that water could be used as a binder for foodstuffs formed without flour.

On pages 9 through 10 of the Answer, the examiner responds and states that Pulici was relied upon for teaching the step of

spraying an edible adhesive (water). However, the examiner does not explain why one of ordinary skill in the art would have been motivated to substitute the drop of corn syrup used for the particular rolled food product of Laschkewitsch, with spraying of water, as set forth in Pulici (used in the context of foodstuffs, such as burritos and enchiladas or Chinese egg rolls or cannelloni). We agree with appellants that Laschkewitsch's flowable food product is, e.g., candy or a dehydrated fruit based material, that is placed on individual strips of paper. See page 7, lines 5 through 12 of Laschkewitsch. The examiner has not convincingly explained why one of ordinary skill in the art would have been motivated to have utilized a spraying method, and to have utilized water as the adhesive, in the context of this food product used in Laschkewitsch, especially in view of the fact that Pulici's food product (burritos and enchiladas, etc.) is a different food product. We note that the initial burden of presenting a prima facie case of unpatentability on any ground rests with the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We also note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the reference or the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d at 1074, 5 USPQ2d 1596 at 1598 (Fed. Cir. 1988). Here, the examiner has not provided such a teaching, suggestion, motivation, or explanation. The examiner's conclusion that it would have been obvious because Laschkewitsch and Pulici are each directed to "methods of producing rolled products" ignores the import that Laschkewitsch's food product is different from Pulici's food product. Because of this lack of teaching, suggestion,

motivation, or explanation, we determine that the examiner has not established a prima facie case of obviousness. We therefore reverse the rejection of claims 1 through 4.

IV. The rejection of claims 16 through 20 under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Zoss

We consider claims 16 and 17 in this rejection.

Because claims 16 through 20 directly or indirectly depend upon claim 15, we reverse this rejection also for the same reasons that we reverse the rejection of claim 15 discussed above.

V. The rejection of claims 5 through 10 under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Pulici and further in view of Zoss

We consider claim 5 in this rejection.

Because claims 5 through 10 either directly or indirectly depend upon claim 1, we reverse this rejection for the same reasons that we reverse the rejections of claims 1 through 4, discussed above.

VI. Conclusion

The rejection of claim 14 under 35 U.S.C. § 102(a) as being anticipated by Laschkewitsch is affirmed.

The rejection of claim 15 under 35 U.S.C. § 103 as being obvious over Laschkewitsch is reversed.

The rejection of claim 1 through 4 under 35 U.S.C. § 103 as being obvious over Laschkewitsch in view of Pulici is reversed.

Appeal No. 2003-0255
Application No. 09/150,692

The rejection of claims 16 through 20 under 35 U.S.C. § 103 as being obvious over Laschkewitsch in view of Zoss is reversed.

The rejection of claims 5 through 10 under 35 U.S.C. § 103 as being unpatentable over Laschkewitsch in view of Pulici and further in view of Zoss is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

Terry J. Owens
TERRY J. OWENS)
Administrative Patent Judge)
Romulo H. Delmendo
ROMULO H. DELMENDO)
Administrative Patent Judge)
Beverly A. Pawlikowski
BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

bap/vsh

Appeal No. 2003-0255
Application No. 09/150,692

JOHN A. O'TOOLE
P.O. BOX 1113
MINNEAPOLIS, MN 55440

Appendix

1. Method for fabricating a rolled food item, comprising:
providing a strip of support material and food, with the strip of support material and food having a trailing edge and a leading edge, with the food having a tackiness;

rolling the strip of support material and food into a roll having a periphery and a center, with the support material located on the outside of the roll, with the trailing edge located on the periphery of the roll and with the leading edge located adjacent the center of the roll; and

spraying a deposit of a source of moisture at least on the food adjacent to the trailing edge prior to its rolling into the roll, with the source of moisture increasing the tackiness of the food sufficient for the food to be adherable to the support material in the roll to at least prevent unrolling of the roll during fabrication of the rolled food item.

4. The method of claim 2 wherein spraying the deposit comprises spraying the deposit with a food grade water free of adhesive type additives.

5. The method of claim 3 wherein providing the strip comprises providing a strip of support material having side edges and providing food having side edges spaced inwardly from the side edges of the strip of support material.

14. Rolled food item comprising, in combination:

a strip of support material and food, with the strip of support material and food having a trailing edge and a leading edge, with the strip of support material and food being rolled in a roll having a periphery and a center, with the support material located on the outside of the roll, with the trailing edge located on the periphery of the roll, with the leading edge located adjacent the center of the roll, with the food having a first portion adjacent the trailing edge and a second portion of

Appeal No. 2003-0255
Application No. 09/150,692

a substantially longer length than the first portion, with the first portion of the food having a moisture content greater than the moisture content of the second portion and so that the tackiness of the food is sufficient for the food to adhere to the support material in the roll to at least prevent unrolling of the roll during fabrication of the rolled food item.

15. The rolled food item of claim 14 wherein the first portion has a length approximately 10% of the length of the strip of support material and food between the trailing and leading edges.

16. The rolled food item of claim 15 wherein the food has side edges spaced inwardly from the side edges of the strip of support material and with the first portion having side edges spaced inwardly from the side edges of the food.

17. The rolled food item of claim 16 wherein the food comprises a strip of food having leading and trailing edges coextensive with the leading and trailing edges of the strip of the support material, with the first portion having a trailing edge coextensive with the trailing edge of the strip of food.